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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,413	02/06/2002	Christopher Raymond Jones	01760/HG	2925

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FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
767 THIRD AVENUE
25TH FLOOR
NEW YORK, NY 10017-2023

EXAMINER

EINSMANN, MARGARET V

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 10/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-9

Office Action Summary

Application No.

09/980,413

Applicant(s)

JONES ET AL.

Examiner

Margaret Einsmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 8-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 8-14, 16, 17 is/are rejected.
- 7) ☐ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

((a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8,9,10,11 are rejected under 35 U.S.C. 102(a) as being anticipated by Fidoe et al, WO 99/17614.

A composition comprising trishydroxymethyl phosphine (THP) or tetrakis (hydroxymethyl)phosphonium salt sealed in a PVA bag is disclosed. Said THP contains .1-50% of THP and has a moisture content of 0-10%. Page 3 second paragraph. When THP is intended for use in the leather industry, patentee states that solid THP may be combined with other tanning agents, such as chrometan, alum or zirconium tanning agents. Synthetic tanning agents (Syntans) as listed on page 4 third paragraph may also be added. See page 3 fifth paragraph and page 4 second, third and fourth full paragraphs. Claim is included in this rejection since the condensate is alternatively claimed.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Windus , US 3,104,151 in view of Fidoe et al as applied to claim 8 above.

Windus discloses tanning leather with two different tanning composition, one being tetrakis (hydroxymethyl) phosphonium chloride and the other a mineral tannage or a syntan. The skins may be tanned simultaneously with the mineral syntan (aldehyde tannage) or sequentially with the THPC and aldehyde tannage or sequentially with the THPC and mineral tannage. See col 2 lines 7-56. Said tanned skins are fat liquored and finished as grain leather subsequently to tanning. See col 3 lines 51-52. Fidoe et al discloses a composition comprising a tetrakis (hydroxymethyl)phosphonium salt , including the chloride salt, sealed in a PVA bag for use in leather tanning. It would have been obvious to the skilled artisan to use that tetrakis (hydroxymethyl) phosphonium salt in the PVA bag disclosed by Fidoe et al. in the process of Windus for the benefits taught by Fidoe et al. on page 3 fourth paragraph, that is, to make dosing simpler, to protect THP against atmospheric deterioration, and prevent contact between the user and the product.

Response to Amendment

Applicant's amendment deleting "dialdehyde starch" from the claims has mooted the rejection of claims 8-11, 13,14 over Windus under 35 USC 102(b) as applied on page 3 of the office action of July 7, 2003

Applicant's arguments filed September 19, 2003 with respect to the rejections over Fidoe et al. have been fully considered but they are not persuasive for the following reasons. Applicant argues that with respect to the anticipation rejection:

- 1) applicant is not using a composition of a THP or a tetrakis(hydroxymethyl) phosphonium salt sealed in a PVA bag and
- 2) The THP has greater than 80% THP.

In response to applicant's first argument, this office points to claim 8 wherein the form of the polyvinyl alcohol is not mentioned. Accordingly the PVA bag holding THP as provided by Fidoe et al. anticipates the claims.

In response to applicant's second point, claims 8-11 do not state the percentage of THP in the compositions.

Applicant further argues with respect to the obviousness rejection that the instant specification teaches away from using the phenol copolymer as the source of THP in the tannage, which is used in Windus. In response to this argument, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's response has necessitated the following new grounds of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16 and 17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no basis in the specification for the subject matter claimed in claims 16 and 17. Applicant points to page 8 third paragraph for the basis. That paragraph discloses a relationship between THP and Moderator, not a molar relationship between THP and $\text{RP}(\text{CH}_2\text{CH})_3$ as claimed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 16 and 17 are not properly dependent on claim 8 because claim 8 claims one of THP and $\text{RP}(\text{CH}_2\text{OH})_3$ while applicant claims a mixture of both.

Allowable Subject Matter

Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Margaret Einsmann
Primary Examiner
Art Unit 1751

October 16, 2003